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Jerome Dale Johnson

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HERSHKOVITZ & ASSOCIATES
2845 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

PASS, NATALIE

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/739,448

Applicant(s)

JOHNSON ET AL.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2007 and 17 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 20-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 20-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 July 2007 has been entered.
2. This communication is in response to the Request for Continued Examination filed on 11 July 2007 and the amendment filed on 17 May 2007. Claims 1, 11, 30 have been amended. Claims 50-52 have been newly added. Claims 12-19 have been previously cancelled. Claims 1-11, 20-52 are currently pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 50-52 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Newly added claims 50-52 recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- “comparing [compare] the customer data with the plan requirements data from the stored insurance plan products,” as disclosed in claims 50, 51, and 52 at lines 6-7, 8-9, and 11-13, respectively; and
- “proposal in the computer system that is different from the stored insurance products,” as disclosed in claims 50, 51, and 52 at lines 19-20, 21-22, and 23-24, respectively.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

- a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 20 December 2000. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be

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amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 20 December 2000.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 50-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claims 1, 50-52 recite “ ... [...] ... presenting [present] a description of insurance plan options available to the customer ... [...] ... ” on lines 11, 13, 15, 18-19, which appear to recite presenting a description of only those plans that are available to the customer, however claims 1, 50-52 also recite “the description of insurance plan options including an indication that a particular insurance plan has been determined to not be currently available to the customer ... [...] ... ” It is unclear how within a description of insurance plan options available to the customer can be included an indication that a plan has been determined to be not available.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1-11, 20-27, 30-47, 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood, U.S. Patent Number 4, 567, 359 in view of Warady, U.S. Patent Number 6, 067, 522 for substantially the same reasons given in the prior Office Action (paper number 20061226). Further reasons appear hereinbelow.

(A) Claims 1, 11, and 30 have been amended to include the recitation of

- “by using [the] one or more modules” in lines 3-4, 8-9, 13-14, and 19, 6-7, 11-12, 17-18, and 23, 4, 14, 18, and 23, respectively.

As per claim 1, Lockwood teaches a method for generating a customized proposal in the development of insurance plans for a customer (Lockwood; column 6, lines 3-11), the method comprising steps of:

storing customer data within a database in a computer system (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 37 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30) by using one or more modules (Lockwood; Abstract, column 2, lines 48-55) (Examiner interprets Lockwood’s teachings of “programmed to gather a predetermined sequence of information from a customer on the services in which the customer is interested ... [...] ... transmit the information to the central data processing center ... [...] ... extracts the desired information from its storage ... [...] ... transmits it back to the terminal ... [...] ... relayed to the customer” (Lockwood; column 2, lines 48-55) to teach a form of using one or more software modules), the database having stored therein insurance plan products with plan requirements data (Lockwood; column 5, lines 37-48); Examiner interprets Lockwood’s teaching of “[t]he memory

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23 stores program information and information on insurance policies and prices for various insurance companies, which are periodically up-dated from the terminals 4 of the various companies, and information on policy quotes and sales, which can be accessed periodically by the respective insurance company terminals ... [] ... to perform insurance quotation calculations in response to customer information received from any of the terminals, to send quotation data to the respective terminal” (Lockwood; column 5, lines 37-48) to necessarily include storing in the “memory” (reads on “database”) plan requirements data in order to produce the insurance quotation;

presenting a description of insurance plan options available to the customer on a “terminal” (reads on “display device of the computer system”) (Lockwood; column 3, lines 9-48, column 6, lines 5-11) based upon the stored customer data and the user selected plan options by using the one or more modules (Lockwood; Abstract, column 2, lines 48-55) (Examiner interprets Lockwood’s teachings of “programmed to gather a predetermined sequence of information from a customer on the services in which the customer is interested ... [...] ... transmit the information to the central data processing center ... [...] ... extracts the desired information from its storage ... [...] ... transmits it back to the terminal ... [...] ... relayed to the customer” (Lockwood; column 2, lines 48-55) to teach a form of “presenting a description of insurance plan options available to the customer ... [...] ... by using the one or more modules”);

generating a customized proposal in the computer system based upon a selection made from the presented insurance plan options that includes a description of an insurance plan (Lockwood; column 3, lines 9-48, column 6, lines 17-32) by using the one or more modules (Lockwood; column 2, lines 48-55), at least a portion of the customer data, and estimated costs

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for the insurance plan (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

Although Lockwood teaches using one or more modules (Lockwood; column 2, lines 48-55), Lockwood fails to explicitly disclose

determining if a particular insurance plan may be offered but is not currently available to the customer based upon the stored plan requirements data and either the stored customer data or user selected plan options by using the one or more modules, the user selected plan options being obtained from an input device of the computer system; and

the description of insurance plan options including an indication that a particular insurance plan has been determined to not be currently available to the customer.

However, the above features are well-known in the art, as evidenced by Warady.

In particular, Warady teaches

determining if a particular insurance plan may be offered but is not currently available to the customer based upon the stored plan requirements data and either the stored customer data or user selected plan options by using the one or more modules (Warady column 9, line 58 to column 10, line 8) the user selected plan options being obtained from an input device of the computer system (Warady; column 13, lines 50-53); in view of the fact that the “system” consists of one or more modules, (Warady; Figure 1, column 8, lines 20-35), Examiner interprets Warady’s teachings of “the ... [...] ... system ... [...] ... generates ... [...] ... enrollment form for each employee described in the employee data files 20 and eligible to receive one or more benefits ... [...] ... according to the data and instructions entered into the benefit files 10, the

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employee data files 20, the sponsor file 30, and the code file 40 in step S1 and are individualized for each employee to include, for example, all benefit plans and coverage options that are available to be selected by the employee as well as prices and credits (if any) associated with each benefit plan and coverage option ... [...] ... the information included in each enrollment form can be based, for example, on relevant characteristics of the employee, such as job classification, division, work location, age and salary, and rules established by the employer” (emphasis added) (Warady column 9, line 58 to column 10, line 8) to teach a form of “determining if a particular insurance plan may be offered but is not currently available to the customer based upon the stored plan requirements data and either the stored customer data or user selected plan options by using the one or more modules”; and

the description of insurance plan options including an indication that a particular insurance plan has been determined to not be currently available to the customer (Warady; column 4, line 51 to column 5, line 5, column 5, line 65 to column 6, line 7); Examiner interprets Warady’s teachings of “tables of information that describe the employer ... [...] ... , the employer's health and welfare benefit policies, the benefit plans in which the employer's employees can be enrolled ... [...] ... information can include, for example, the benefit types and coverage options available to the employees for enrollment selection, identification of which benefits are employee selectable and which are attached to other employee selections [reads on “indication that a particular plan has been determined to not be currently available to the customer” as it is tied to other employee selections]... [...] ... , identification of [particular] plan features that generate cost or premium billings based on other employee selections but are not benefits disclosed to or payable to employees (e.g., stop loss insurance which protects the

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employer against excessive claims under self-insured plans) ... [...] ... It should be appreciated that additional or different information can be included in the benefit files as needed to accommodate different types of benefit plans or employer policies,” (emphasis added) (Warady; column 4, line 51 to column 5, line 5) to teach a form of “the description of insurance plan options including an indication that a particular insurance plan has been determined to not be currently available to the customer.”

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Lockwood to include the description of insurance plan options including an indication that a plan may be offered but is not currently available to the customer based upon the plan requirements data and either other selected plan options or the customer data, as taught by Warady, with the motivations of enabling enrollment forms that are customized for each employee on an individual basis, providing a system that manages health and welfare benefit enrollment information, that can communicate the information to interested parties such as, for example, participating employees and plan providers, and produce the billings needed for each plan provider's premiums and/or fees, and reduce time wasted and human error by employers and employees implementing and administering health and welfare benefit plans (Warady, column 1, lines 44-45, 57-61, column 2, lines 35-45).

(B) As per claims 2-5, Lockwood and Warady teach a method as analyzed and discussed in claim 1 above:

further comprising a step of printing the customized proposal (Lockwood; column 7, lines 5-24);

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wherein the generating step comprises providing insurance company data as part of the customized proposal (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30);

further comprising a step of providing the customized proposal in electronic form to the customer (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24; column 7, line 60 to column 8, line 2, column 9, lines 13-30); and

wherein the generating step comprises deriving the estimated costs from information sorted in the database (Lockwood; column 3, lines 9-48, column 6, lines 17-32).

(C) As per claims 6-8, Lockwood and Warady teach a method as analyzed and discussed in claim 1 above:

further comprising a step of obtaining the user selected plan options from the input device of the computer system (Lockwood; column 3, lines 17-25, column 6, lines 3-4);

wherein the indication that a plan has been determined to not be currently available to the customer comprises conditions which are not met for the customer to qualify for the offered but currently not available insurance plan (Warady; column 4, line 51 to column 5, line 5, column 5, line 65 to column 6, line 7); Examiner interprets Warady's teachings of " ... [...] ... prerequisites table 110 stores information describing which benefit plans, if any, described in the benefit tables 100 have prerequisites that must be met before an employee can be enrolled in the plans. For example, certain life insurance plans require evidence of insurability of an employee to be approved by the plan provider before the employee is eligible to receive the chosen benefit or

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level of coverage. In this example, the prerequisites table 110 could store information describing the conditions under which evidence of insurability is required by the plan provider ... [...] ...”

(Warady; column 5, line 65 to column 6, line 7) to teach a form of “wherein the indication that a plan has been determined to not be currently available to the customer comprises conditions which are not met for the customer to qualify for the offered but currently not available insurance plan;”

wherein the presenting step comprises:

selecting, with the input device (Lockwood; column 6, lines 3-4) one or more sets of possible insurance plans from the insurance plan options presented to the customer on the display device (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30);

determining an estimated cost for each of the selected sets of insurance plans (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30); and

generating a customized comparison for the possible set of insurance plans in the sales computer system that includes the customer data, the description of the selected insurance plans, and the estimated costs for the selected set of insurance plans (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

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The motivations for combining the respective teachings of Lockwood and Warady are as given in the rejection of claim 1 above, and incorporated herein.

(D) As per claims 9-10, Lockwood and Warady teach a method as analyzed and discussed in claim 1 above

wherein the available insurance plan options comprise a plurality of health insurance plans (Lockwood; column 3, lines 32-36);

further comprising a step of transmitting the customer data and the user selected plan options from the computer system to a remote server system for processing of a request for insurance (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

(E) Claim 11 differs from method claim 1 by reciting a “computer program product readable by a computer system ... ” in the preamble. As per this limitation, Lockwood clearly discloses his invention to be implemented on a computer program product readable by a computer system ... (Lockwood; Figure 1, column 2, lines 8-18, 34-46). The remainder of claim 11 repeats the limitations of claim 1, and is therefore rejected for the same reasons given above for claim 1.

The motivations for combining the respective teachings of Lockwood and Warady are as given in the rejection of claim 1 above, and incorporated herein.

(F) As per claims 20-23, Lockwood and Warady teach a method as analyzed and discussed in claim 1 above

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wherein the generating step comprises providing an insurance plan as part of the customized proposal (Lockwood; column 3, lines 9-48, column 6, lines 17-32);

wherein the generating step comprises gathering “predetermined customer information” (reads on providing insurance application forms”) as part of the customized proposal (Lockwood; column 3, lines 15-16);

wherein the generating step comprises providing “a series of quotations from various institutions... purchaser can compare quotations” (reads on “benefit charts data”) as part of the customized proposal. (Lockwood; column 3, lines 32-33); and

wherein the generating step comprises providing provider information data as part of the customized proposal (Lockwood; column 7, lines 5-12).

(G) As per claims 24-27, Lockwood and Warady teach a method as analyzed and discussed in claim 1 above

wherein the available insurance plan options comprise a plurality of dental insurance plans (Warady; column 4, lines 1-19);

wherein the available insurance plan options comprise a plurality of life insurance plans (Warady; column 4, lines 1-19);

wherein the available insurance plan options comprise a plurality of disability insurance plans (Warady; column 4, lines 1-19); and

wherein the insurance plan comprises a set of insurance plans (Warady; column 4, lines 1-19).

The motivations for combining the respective teachings of Lockwood and Warady are as given in the rejection of claim 1 above, and incorporated herein.

(H) Claim 30 differs from method claim 1, in that it is a system rather than a method for generating a customized proposal in the development of insurance plans for a customer.

System claims 30-47 repeat the subject matter of claims 1-3, 20-23, 4-7, 8-9, 24-26, 10, and 27 respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 1-3, 20-23, 4-7, 8-9, 24-26, 10, and 27 have been shown to be fully disclosed or obvious by the collective teachings of Lockwood and Warady in the above rejection of claims 1-3, 20-23, 4-7, 8-9, 24-26, 10, and 27, it is readily apparent that the system disclosed collectively by Lockwood and Warady includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1-3, 20-23, 4-7, 8-9, 24-26, 10, and 27, and incorporated herein. As per the recitation in claim 39 of “the input device processor unit is configured to prompt the user to input selected plan options,” Examiner interprets Lockwood’s teachings of “[t]he presentation solicits and allows the customer to enter information at various points via the touch pad 13 displayed on the monitor screen” (Lockwood; column 5, lines 7-9, column 6, lines 2-13) to teach a form of this limitation.

(I) As per newly added claim 50, Lockwood and Warady teach a method for generating a customized proposal in the development of insurance plans for a customer (Lockwood; column 6, lines 3-11), the method comprising:

storing customer data within a database in a computer system (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 37 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30) by using one or more modules (Lockwood; Abstract, column 2, lines 48-55)

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(Examiner interprets Lockwood's teachings of "programmed to gather a predetermined sequence of information from a customer on the services in which the customer is interested ... [...] ... transmit the information to the central data processing center ... [...] ... extracts the desired information from its storage ... [...] ... transmits it back to the terminal ... [...] ... relayed to the customer" (Lockwood; column 2, lines 48-55) to teach a form of using one or more software modules), the database having stored therein insurance plan products with plan requirements data (Lockwood; column 5, lines 37-48); Examiner interprets Lockwood's teaching of "[t]he memory 23 stores program information and information on insurance policies and prices for various insurance companies, which are periodically up-dated from the terminals 4 of the various companies, and information on policy quotes and sales, which can be accessed periodically by the respective insurance company terminals ... [] ... to perform insurance quotation calculations in response to customer information received from any of the terminals, to send quotation data to the respective terminal" (Lockwood; column 5, lines 37-48) to necessarily include storing in the "memory" (reads on "database") plan requirements data in order to produce the insurance quotation;

comparing the customer data with the plan requirements data from the stored insurance plan products by using the one or more modules (Warady; column 5, line 65 to column 6, line 23, column 8, lines 20-46, column 10, lines 55-67); Examiner interprets Warady's teaching of "system 1 generates a confirmation of each employee's enrollment status" (Warady; column 10, lines 55-57) to teach a form of "comparing the customer data with the plan requirements data from the stored insurance plan products by using the one or more modules;"

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determining if a particular insurance plan may be offered but is not currently available to the customer based upon the stored plan requirements data and either the stored customer data or user selected plan options by using the one or more modules (Warady column 9, line 58 to column 10, line 8) ; in view of the fact that the “system” consists of one or more modules, (Warady; Figure 1, column 8, lines 20-35), Examiner interprets Warady’s teachings of “the ... [...] ... system ... [...] ... generates ... [...] ... enrollment form for each employee described in the employee data files 20 and eligible to receive one or more benefits ... [...] ... according to the data and instructions entered into the benefit files 10, the employee data files 20, the sponsor file 30, and the code file 40 in step S1 and are individualized for each employee to include, for example, all benefit plans and coverage options that are available to be selected by the employee as well as prices and credits (if any) associated with each benefit plan and coverage option ... [...] ... the information included in each enrollment form can be based, for example, on relevant characteristics of the employee, such as job classification, division, work location, age and salary, and rules established by the employer” (emphasis added) (Warady column 9, line 58 to column 10, line 8) to teach a form of “determining if a particular insurance plan may be offered but is not currently available to the customer based upon the stored plan requirements data and either the stored customer data or user selected plan options by using the one or more modules,” the user selected plan options being obtained from an input device of the computer system (Lockwood; column 3, lines 9-48, column 5, lines 37-48, column 6, lines 3-32);

presenting a description of insurance plan options available to the customer on a “terminal” (reads on “display device of the computer system”) (Lockwood; column 3, lines 9-48, column 6, lines 5-11) based upon the stored customer data and the user selected plan options by

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using the one or more modules (Lockwood; Abstract, column 2, lines 48-55) (Examiner interprets Lockwood's teachings of "programmed to gather a predetermined sequence of information from a customer on the services in which the customer is interested ... [...] ... transmit the information to the central data processing center ... [...] ... extracts the desired information from its storage ... [...] ... transmits it back to the terminal ... [...] ... relayed to the customer" (Lockwood; column 2, lines 48-55) to teach a form of "presenting a description of insurance plan options available to the customer ... [...] ... by using the one or more modules"), the description of insurance plan options including an indication that a particular insurance plan has been determined to not be currently available to the customer; (Warady; column 4, line 51 to column 5, line 5, column 5, line 65 to column 6, line 7); (Examiner interprets Warady's teachings of "tables of information that describe the employer ... [...] ... , the employer's health and welfare benefit policies, the benefit plans in which the employer's employees can be enrolled ... [...] ... information can include, for example, the benefit types and coverage options available to the employees for enrollment selection, identification of which benefits are employee selectable and which are attached to other employee selections [reads on "indication that a particular plan has been determined to not be currently available to the customer" as it is tied to other employee selections]... [...] ... , identification of [particular] plan features that generate cost or premium billings based on other employee selections but are not benefits disclosed to or payable to employees (e.g., stop loss insurance which protects the employer against excessive claims under self-insured plans) ... [...] ... It should be appreciated that additional or different information can be included in the benefit files as needed to accommodate different types of benefit plans or employer policies," (emphasis added) (Warady; column 4, line 51 to column 5,

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line 5) to teach a form of “the description of insurance plan options including an indication that a particular insurance plan has been determined to not be currently available to the customer”); and

generating a customized proposal in the computer system that is “extracted” from stored information (reads on “different from the stored insurance products”) (Lockwood; column 2, lines 47-60) by the comparing the customer data and the determining of the particular insurance plan, based upon a selection made from the presented insurance plan options that includes a description of an insurance plan by using the one or more modules (Lockwood; column 2, lines 48-55), at least a portion of the customer data, and estimated costs for the insurance plan (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

The motivations for combining the respective teachings of Lockwood and Warady are as given in the rejection of claim 1 above, and incorporated herein.

(J) Claim 51 differs from method claim 50 by reciting a “computer program product readable by a computer system ...” in the preamble. As per this limitation, Lockwood clearly discloses his invention to be implemented on a computer program product readable by a computer system ... (Lockwood; Figure 1, column 2, lines 8-18, 34-46). The remainder of claim 51 repeats the limitations of claim 50, and is therefore rejected for the same reasons given above for claim 50.

The motivations for combining the respective teachings of Lockwood and Warady are as given in the rejection of claim 1 above, and incorporated herein.

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(K) Claim 52 differs from method claim 50, in that it is a system rather than a method for generating a customized proposal in the development of insurance plans for a customer.

System claim 52 repeats the subject matter of claim 50, respectively, as a set of elements rather than a series of steps. As the underlying processes of claim 50 have been shown to be fully disclosed or obvious by the collective teachings of Lockwood and Warady in the above rejection of claim 50, it is readily apparent that the system disclosed collectively by Lockwood and Warady includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 50, and incorporated herein. . As per the recitation in claim 52 of “an input device configured to prompt a user of the computer system to input customer data ... [...] ...,” Examiner interprets Lockwood’s teachings of “[t]he presentation solicits and allows the customer to enter information at various points via the touch pad 13 displayed on the monitor screen” (Lockwood; column 5, lines 7-9, column 6, lines 2-13) to teach a form of this limitation.

10. Claims 28-29, 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood, U.S. Patent Number 4, 567, 359 and Warady, U.S. Patent Number 6, 067, 522, as applied to claim 1 above, and further in view of Gamble, et al., U.S. Patent Number 6, 163, 770 for substantially the same reasons given in the prior Office Action (paper number 20061226). Further reasons appear hereinbelow.

(A) As per claim 28, Lockwood and Warady teach a method as analyzed and discussed in claim 1 above comprising

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wherein the storing step comprising storing the customer data and insurance plan products in a “memory” (reads on “database”) that is hosted in a networked environment (Lockwood; column 2, lines 34-46) with portions stored in a remote memory storage device (Lockwood; column 2, lines 51-54).

Lockwood and Warady fail to explicitly disclose a relational database.

However, the above features are well-known in the art, as evidenced by Gamble.

In particular, Gamble teaches wherein the storing step comprising storing the customer data and insurance plan products in a relational database (Gamble; column 14, lines 34-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Lockwood to include this limitation, as taught by Gamble, with the motivations of generating documentation for insurance policies and of efficiently calculating changes in a claims costs and generating printed insurance documentation (Gamble, column 5, line 58 to column 6, line 46)..

The motivations for combining the respective teachings of Lockwood and Warady are as given in the rejection of claim 1 above, and incorporated herein.

(B) As per claim 29, Lockwood, Warady and Gamble teach a method as analyzed and discussed above comprising

wherein the storing step comprising storing the customer data and insurance plan products in a relational database (Gamble; column 14, lines 34-52) comprising a plurality of modules (Warady; Figure 1, column 8, lines 20-35).

The motivations for combining the respective teachings of Lockwood, Warady and Gamble are as given in the rejections of claims 1 and 28 above, and incorporated herein.

(C) Claims 48-49 differ from method claims 28-29 in that they recite a system rather than a method for generating a customized proposal in the development of insurance plans for a customer.

System claims 48-49 repeat the subject matter of claims 28-29 respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 28-29 have been shown to be fully disclosed or obvious by the collective teachings of Lockwood, Warady and Gamble in the above rejection of claims 28-29, it is readily apparent that the system disclosed collectively by Lockwood, Warady and Gamble includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 28-29, and incorporated herein.

Response to Arguments

11. Applicant's arguments filed 17 May 2007 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 17 May 2007.

(A) At the paragraph bridging pages 15-16 of the 17 May 2007 response Applicant explains limitations in newly added claims 50-52 and attempts to point to support for the new language in Applicant's specification. Examiner thanks Applicant for this information, however Examiner disagrees with the information provided. For example, newly added language includes the limitation "comparing [compare] the customer data with the plan requirements data from the stored insurance plan products by using the one or more modules" (emphasis added). Examiner

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interprets plan requirements data to be data that is required by the plan of the customer, i.e, what the customer must do to qualify for the plan. However, at the bottom of page 12 of the specification (as pointed to by Applicant for support), the comparison that is disclosed is between user requirements and the health plans. Examiner interprets user requirements to be requirements entered by the user. Further, as regards the newly added limitation “proposal in the computer system that is different from the stored insurance products,” (emphasis added), Applicant states, at the paragraph bridging pages 15-16 of the 17 May 2007 response, that “[s]upport for these amendments can be found throughout the specification.” However, the Examiner was unable able to find any support for this newly added language within the specification, and consequently Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

(B) At pages 19-23 of the 17 May 2007 response Applicant argues that the features in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references, including the newly added limitations of the amendment filed 17 May 2007, have been fully addressed by the Examiner as being obvious in view of the combined teachings of Lockwood, Warady and Gamble, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 20061226), and incorporated herein. In particular, Examiner notes that the recited features of “determining if a particular insurance plan may be offered but is not currently available to the customer ... [...]

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... ” are taught by the combination of applied references. Examiner notes that the “system” consists of one or more modules, (Warady; Figure 1, column 8, lines 20-35), and accordingly, Examiner interprets Warady’s teachings of “the ... [...] ... system ... [...] ... generates ... [...] ... enrollment form for each employee described in the employee data files 20 and eligible to receive one or more benefits ... [...] ... according to the data and instructions entered into the benefit files 10, the employee data files 20, the sponsor file 30, and the code file 40 in step S1 and are individualized for each employee to include, for example, all benefit plans and coverage options that are available to be selected by the employee as well as prices and credits (if any) associated with each benefit plan and coverage option ... [...] ... the information included in each enrollment form can be based, for example, on relevant characteristics of the employee, such as job classification, division, work location, age and salary, and rules established by the employer” (emphasis added) (Warady column 9, line 58 to column 10, line 8) to teach a form of “determining if a particular insurance plan may be offered but is not currently available to the customer based upon the stored plan requirements data and either the stored customer data or user selected plan options by using the one or more modules.” In view of the fact that, Warady’s system determines, from among all the benefit plans, those plans that are available to be selected by each employee based on employee characteristics and established rules, Examiner interprets the system to determine those plans that are not currently available to the customer.

Moreover, Examiner interprets Warady’s teachings of “tables of information that describe the employer ... [...] ... , the employer's health and welfare benefit policies, the benefit plans in which the employer's employees can be enrolled ... [...] ... information can include, for example, the benefit types and coverage options available to the employees for enrollment

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selection, identification of which benefits are employee selectable and which are attached to other employee selections [reads on “indication that a particular plan has been determined to not be currently available to the customer” as it is tied to other employee selections]... [...] ... , identification of [particular] plan features that generate cost or premium billings based on other employee selections but are not benefits disclosed to or payable to employees (e.g., stop loss insurance which protects the employer against excessive claims under self-insured plans) ... [...] ... It should be appreciated that additional or different information can be included in the benefit files as needed to accommodate different types of benefit plans or employer policies,” (emphasis added) (Warady; column 4, line 51 to column 5, line 5) to teach a form of “the description of insurance plan options including an indication that a particular insurance plan has been determined to not be currently available to the customer.”

In addition, Examiner interprets Warady’s teachings of

“[t]he prerequisites table 110 stores information describing which benefit plans, if any, described in the benefit tables 100 have prerequisites that must be met before an employee can be enrolled in the plans. For example, certain life insurance plans [reads on “description of insurance plan options”] require evidence of insurability of an employee to be approved by the plan provider before [reads on “is not currently available”] the employee is eligible to receive the chosen benefit or level of coverage. In this example, the prerequisites table 110 could store information describing the conditions under which evidence of insurability is required by the plan provider (e.g., when the employee desires to receive an initial life insurance face amount over \$250,000 or to increase his or her life insurance election after initial enrollment, such as from 2 to 3 times salary) [reads on “description of insurance plan options”] (emphasis added) (Warady; column 5, line 65 to column 6, line 10)

to teach a form of “determining if a particular insurance plan may be offered but is not currently available to the customer based upon the stored plan requirements data and either the stored customer data or user selected plan options.

As such, it is unclear as to how or why Applicant's claimed limitations are not met by at least the aforementioned passages. Perhaps Applicant is relying on features not expressly recited in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As per Applicant's arguments at pages 19-21 of the 17 May 2007 response regarding Figure 7e, these arguments are moot in view of the new grounds of rejection.

As regards Applicant's arguments at page 21, lines 1-6 of the 17 May 2007 response that “Warady's method does not disclose a determining step, a presenting step and a generating a customized proposal based on the status of a particular plan that is not currently available to a customer and Warady does not disclose generating a customized proposal in response to unavailability of an existing plan,” Examiner notes that these are not claimed limitations.

In response to Applicant's argument on page 21, lines 13-14 of the 17 May 2007 response that the Examiner utilized “impermissible hindsight” to recreate the applicant's invention, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include

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knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As per Applicant's arguments in pages 21-22 of the of the 17 May 2007 response that the applied references do not teach generating a customized proposal, Examiner respectfully disagrees. Examiner interprets Lockwood's teachings of "[t]he system as applied to the insurance industry is arranged to give personalized insurance quotations, make sales and take orders," (emphasis added) (Lockwood; column 3, lines 40-42) together with Lockwood's detailed "sequence of operations" (Lockwood; column 5, line 65 to column 6, line 32) resulting in a customized proposal to purchase insurance (see steps (1)-(8)) to teach a form of generating a customized proposal. Moreover, Examiner notes that Warady teaches "[t]he ... [...] ... forms ... [...] ... are ... [...] ... individualized for each employee to include, for example, all benefit plans and coverage options that are available to be selected by the employee as well as prices and credits (if any) associated with each benefit plan and coverage option. Again, the information included in each enrollment form can be based, for example, on relevant characteristics of the employee, such as job classification, division, work location, age and salary, and rules established by the employer ... [...] ... the health and welfare benefit enrollment and billing system 1 also generates a confirmation of each employee's enrollment status including the employee's most recently effective benefit plan and coverage option selections (if any) for the same plan year in case of a mid-year change in employment status, or for the prior plan year in case of a request by the employee for an enrollment form for the next plan year (starting after the request date). Preferably, the confirmation is individualized for each employee ... [...] ... confirmation can assist an employee in making new benefit plan and coverage option selections

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and/or changing his or her existing selections” (Warady; column 9, line 58 to column 10, line 20), which Examiner interprets to read on the argued limitation.

As per Applicant’s arguments on page 22 of the 17 May 2007 response regarding the “current availability of a particular insurance plan,” these issues have been discussed earlier in this Office Action.

With regard to Applicants arguments on page 22 regarding Figure 7e in the Warady reference, Examiner notes that Applicant appears to rely upon only a small subset of Examiner's applied art. Further it is the entire combined applied reference(s), and not only the cited passages that must be considered when evaluating whether or not the applied references teach the cited limitations.

Conclusion

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label “PROPOSED” or “DRAFT” on the front page of the communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

October 24, 2007



MATTHEW S. GART
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600